

## REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of September 5, 2008 and respectfully requests reconsideration of the application.

Claims 1-17 and 22-38 are now pending, a total of 34 claims. Claims 1, 6, 9, 15, 25 and 30 are independent.

### **I. The Office Action is Insufficient to Raise Any Rejection or Permit Any Response**

The September 5, 2008 Office Action is really, really bad, and is more suggestive of deliberate obstruction by the Examiner than of a *bona fide* examination of the claims.

#### **A. Examiner Hsu Repeatedly Ignores Claim Language and Fails to Answer All Material Traversed**

Claim 15 as examined recited as follows:

15. A method comprising the steps of:

receiving from a user a selection of event contests, from among the plurality of contests within an event, and a selection of contestants in each of a plurality of the event's contests, and establishing a unified wager based on the outcome of the selected contestants, the selections available to the user include selecting contestants from a **non-consecutive plurality of contests** within the event; and

paying the user a winning on the unified wager based on the performance of the selected contestants in the selected contests.

To the degree that the portion of the Office Action directed to claims 1 and 15 can be identified at all (the Action is very unclear about which claim is being discussed where), the Action is **dead silent** on the claim language “non-consecutive plurality of races” or “contests” and receiving a user's “selection of event contests ... from among the contests within an event.” Applicant's last paper (December 17, 2007, pages 13-14) specifically drew Examiner Hsu's attention to this claim language.

**How can prosecution advance when an examiner ignores the same claim language in two successive Actions and fails to Answer All Material Traversed?**

Since this claim language has been overlooked twice by Examiner Hsu, several of the independent claims are now amended to recite the “non-consecutive” limitation twice or even three times, multiply, redundantly, and repetitively. This amendment has no effect on claim scope, it is merely an amendment to reduce the chance of further examiner error.

The September 2008 Action is too incomplete to constitute an examination of the application, or to raise any rejection of any claim. Any future rejection that considers the language “non-consecutive plurality of races” will necessarily be a “new ground” not necessitated by amendment, and that will prevent final rejection under MPEP § 706.

**B. The Office Action Does Not Discuss the Claims With Precision**

Pages 2-5 discuss a total of 25 claims as one undifferentiated blob, without distinguishing which language is drawn from what claim. The independent claims are somewhat different from each other, and the precision of the claim language is buried in the imprecision of the Office Action.

Imprecise Office Actions tend to reflect imprecise thinking, and lead to prosecution delays. Applicant requests that the independent claims be discussed with precision, for example in the manner of claims 7-8 and 14 at the bottom of page 5.

**C. Reliance on “Inherency” Exceeds Permissible Bounds**

The Office Action asserts inherency for several propositions (because the paragraphs are not numbered and one paragraph runs on over nearly two pages, Applicant cannot direct the Examiner’s attention precisely):

[1] It is also of note that it is an inherent aspect of placing a wager to choose what wager’s are to be included in an event in order to provide flexibility in a wagering system or else the player would not be able to accurately place a bet on what he/she would like to wager on.

[2] Although Brenner does not explicitly recite the incorporation of forming at least a portion of each bet to form a pool and sending at least a portion of the pool to each of the identified winning players, it is an inherent attribute that wages in racing events are performed in this manner.

[3] Furthermore, the ability to receive an additional wager after a racing event has begun is an inherent property of race wagers.

There are several errors in these assertions of inherency.

First, the first assertion is not an accurate statement of the claim language, reflecting the general imprecision of the Office Action. Even if this statement is inherent, it does not reflect the claims, and does not advance prosecution.

Second, the Action fails to follow MPEP instructions for “inherency,” MPEP § 2112(IV), citations and quotations omitted:

## **2112 Requirements of Rejection Based on Inherency; Burden of Proof**

### **IV. EXAMINER MUST PROVIDE RATION-ALE OR EVIDENCE TENDING TO SHOW INHERENCY**

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ... To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."

Unless the examiner has provided some "basis in fact and/or technical reasoning" that excludes any other possible reading of the reference, the rejection is incomplete. Here, the first and third assertions of inherency lack the required showing – at most, the first merely states that the property would be desirable in some contexts, not that it necessarily exists in all contexts. The third simply asserts inherency exists, with no explanation at all. This is procedurally inadequate.

Third, the allegations of inherency are simply wrong – in each case, alternatives exist. In most cases, these alternatives are the way things actually work most of the time. With respect to the first alleged inherency, it is entirely possible for the track to select the races to be covered by a particular bet, not the user or player. Indeed, that is what is shown in both the Brenner and WWG references. With respect to the second, in conventional pari-mutuel pools, all of the participants in any one pool bet on the same race or group of races, not on different pluralities of races chosen by the bettors, as recited in some of the claims. The third asserted inherency is pure nonsense – there is certainly no necessity that betting continue after the race begins, indeed that is a rarity – in almost all race betting contexts, betting closes when the race begins, or usually some minutes earlier.

Fourth, this is a § 103 context, not a § 102 context. "Inherency" applies only to a limited extent in a § 103 context. MPEP § 2112(V) (contrasting "inherency under 35 U.S.C. 102" vs. "*prima facie* obviousness under § 103"); *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966) ("That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.") The Examiner made no showing that the alleged inherencies comport with the limited role of inherency in obviousness.

**D. The Office Action is Too Incomplete to Permit a Direct Reply**

The Office Action does not articulate complete statements on any claim, and this Applicant has found that it is a fool's errand to try to speculate what an examiner might have in mind but did not put on paper,

Until a complete, clear, organized, and rule-compliant Office Action is stated, Applicant can go no further than to articulate the defects.

**II. Dependent claims**

The dependent claims are rejected over the art. They are patentable with the independent claims discussed above. In addition, the dependent claims recite additional features that further distinguish the art.

**III. Demand Under 37 C.F.R. § 1.104(d)(2)**

The paper of September 5, 2008 asserts a number of facts based on the personal knowledge of the Examiner, unsupported by substantial evidence. If any such assertion is reiterated in any future paper, Applicant calls for a reference or affidavit, pursuant to 37 C.F.R. § 1.104(d)(2).

**IV. Designation of Paragraphs in the Office Action**

The Examiner's attention is drawn to MPEP § 707.07(k):

**707.07(k) Numbering Paragraphs**

It is good practice to number the paragraphs of the Office action consecutively. This facilitates their identification in the future prosecution of the application.

The examiner's attention is also drawn to the menu in Microsoft Word, Format > Bullets and Numbering, which gets to this dialog box:

The screenshot shows the 'Bullets and Numbering' dialog box with the 'Numbered' tab active. The 'None' option is selected for the list style. The 'Restart numbering' radio button is selected. The 'Customize...' button is visible. The dialog box also shows options for 'Bulleted', 'Outline Numbered', and 'List Styles'. The 'List Styles' section shows '1. List Number', '2. List Number', and '3. List Number'. The 'Restart numbering' radio button is selected. The 'Customize...' button is visible. The 'Reset', 'OK', and 'Cancel' buttons are at the bottom.

The Examiner will observe that this Reply paper is remarkably less clear than it would have been had there been paragraph numbers in the Office Action to which to refer.

#### V. Conclusion

Applicant hereby authorizes the USPTO to communicate with any authorized representative concerning this application by electronic mail.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. A Petition for Extension of Time extends time to reply through today, March 5, 2009. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this reply timely.

Application Serial No. 10/784,353

Attorney Docket No. 04-7131

Amendment Dated March 5, 2009 – Reply to Office Action of September 5, 2008

Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 04-7131.

Respectfully submitted,

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Dated: March 5, 2009

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